

REMARKS

At the time of the Office Action dated May 13, 2005, claims 1-39 were pending and rejected in this application. At the outset, Applicant notes that claims 23 and 24 have not been rejected based upon the applied prior art; and thus, Applicant proceeds on the basis that claims 23 and 24 are allowable over the applied prior art.

On page 2 of the Office Action, the Examiner objected to both the specification and the claims. Specifically, the Examiner asserted that the term "apple" should read "applet." In response, Applicant notes that both the specification and claims have been amended in the manner suggested by the Examiner.

CLAIMS 1-3, 6-13, 16-20, 29-30 AND 32-39 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY GINTER ET AL., U.S. PATENT NO. 5,892,900 (HEREINAFTER GINTER)

On pages 2-7 of the Office Action, the Examiner asserted that Ginter discloses the claimed invention. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. That burden has not been discharged.

Moreover, the Examiner neither clearly designated the teachings in Ginter being relied upon nor clearly explained the pertinence of Ginter. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).¹ For example, as to the claimed limitation with claim 1 of:

embedding in said computer readable content, instruction codes operable to direct a processor circuit to automatically establish a connection to a server, when said content is in use by said processor circuit, to transmit registration information to said server

the Examiner cites to ten different passages in Ginter, which combined, contains over 4 columns of text and references to several drawings. However, given the amount of disclosure found in these passages, the Examiner provided little explanation as to why each and every one of these citations was necessary to factually support an assertion that Ginter discloses the limitation recited above. As noted above, 37 C.F.R. § 1.104(c) requires that "the particular part relied on must be designated as nearly as practicable" and the "pertinence of each reference, if not apparent, must be clearly explained."

As another example, claim 1 recites the following limitation:

operable to control further use of said content by said processor circuit in response to a key received from said server

for which the Examiner cites to eight different passages in Ginter, which combined, again contains over 4 columns of text. The citation of this much text, without clear explanation, serves

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

to obfuscate the specific features within Ginter that the Examiner believes identically discloses the claimed invention.

Applicant does note, however, that the statement of the rejection includes some clarifications as to what features in Ginter the Examiner believes identically disclose the claimed invention. For example, the Examiner asserts that the computer readable content is disclosed by VDE object 300, the instruction codes is disclosed by VDE 100 (also PPE 650 and other SPU 500 processes), the processor circuit is disclosed by electronic application 600, and the server is disclosed by (VDE administrator or clearinghouse).

As to the Examiner's assertion regarding the claimed instruction codes (i.e., VDE 100), the Examiner is referred to Fig. 1 and column 53, lines 39-51. As evident from this passage VDE 100 is very different from the claimed instruction codes. Instead, as stated on column 53, line 63, "Virtual distribution environment 100 is 'virtual'." Thus, VDE 100 fails to identically disclose the claimed instruction codes.

The Examiner also referred to "PPE 650 and other SPU 500 processes" as identically disclosing the claimed instruction codes embedded in the computer readable content. A "Protected Processing Environment" PPE 650 is discussed in column 12, lines 48-52. As noted in this passage, the terms PPE 650, HPE 655, and SPE 503 are used interchangeably. Claim 1, however, recites that the claimed instruction codes (i.e., the Examiner's asserted PPE 650) is embedded in the computer readable content (i.e., the Examiner's asserted VDE 300). However,

referring to Fig. 10 of Ginter, the VDE objects 300 are located separate from HPE 655, SPE 503 (i.e., the PPE 650), and thus; PPE 650 cannot identically disclose the claimed instruction codes.

As to the Examiner's assertion regarding "other SPU 500 process," the Examiner has failed to specifically identify any processes within Ginter that identically correspond to the claimed "instruction codes" that are also embedded in a computer readable content (i.e., the Examiner's asserted VDE object 300).

Fig. 5B discloses the VDE object 300 and a discussion of Fig. 5B is found in column 59, lines 42 through column 60, line 6 of Ginter. A review of Fig. 5B and the accompany discussion does not yield any apparent disclosure of instruction codes, corresponding to that claimed, that are embedded in the VDE object 300. Therefore, Applicant respectfully submit that Ginter fails to identically disclose the claimed invention, as recited in claim 1. Independent claims 6, 10, 29-30, 32, and 36 each include a comparable limitation to that found in claim 1, which Applicant has argued is not identically disclosed by Ginter. Applicant, therefore, respectfully submits that the imposed rejection of claims 1-3, 6-13, 16-20, 29-30 and 32-39 under 35 U.S.C. § 102 for anticipation based upon Ginter is not factually viable and, hence, solicits withdrawal thereof.

**CLAIMS 10, 12, 15 AND 20-21 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY STEFIK ET AL., U.S. PATENT NO. 6,236,971 (HEREINAFTER STEFIK)**

On pages 7-8 of the Office Action, the Examiner asserted that Stefik discloses a method corresponding to that claimed. This rejection is respectfully traversed.

Independent claim 10 recites, in part, "executing instruction codes embedded in said computer readable content." In the statement of the rejection, the Examiner asserted that the "usage rights" disclosed by Stefik are comparable to the claimed instruction codes. Applicant respectfully disagrees.

Referring to Fig. 7 and column 10, lines 4-6 of Stefik, the rights portion 104 (i.e., the usage rights) "will contain a data structure, such as a look-up table, wherein the various information with a right is maintained." One having ordinary skill in the art would have construed the term of "executing instruction codes" to arrive at the plain meaning that this term is directed to "instruction codes" that are executable (i.e., computer/program code). This feature is completely different than the data structure disclosed by Stefik. Thus, given the plain meaning of the term "executing instruction codes ...", one having ordinary skill in the art would not consider the rights portion 104 (i.e., usage rights) of Stefik to identically disclose this claimed feature. Applicant, therefore, respectfully submits that the imposed rejection of claims 10, 12, 15, and 20-21 under 35 U.S.C. § 102 for anticipation based upon Stefik is not factually viable and, hence, solicit withdrawal thereof.

**CLAIMS 4-5, 25-28 AND 31 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON GINTER**

On pages 8-11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Ginter to arrive at the claimed invention. This rejection is respectfully traversed.

Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of the claims under 35 U.S.C. § 102 for anticipation based upon Ginter. Specifically, Ginter neither discloses nor suggests embedding instruction code, corresponding to that claimed, in a computer readable medium.

Furthermore, Applicant submits that the Examiner has not established a prima facie basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and lack of the requisite realistic motivation.² In particular, the Examiner has failed to make the requisite factual findings to support the Examiner's assertion that it is conventional to embed a self-executing applet in a computer readable content to enforce usage permissions of content.³ Although the Examiner can take official notice of facts outside of the record, these facts must be of such a notorious character so as to be instantly and unquestionably recognized as "well-known" in the art. See M.P.E.P. § 2144.03. As also discussed in M.P.E.P. § 2144.03, Applicant has

² In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for: (1) claim limitations; and (2) the motivation to combine references or modify a reference in the reasonable expectation of achieving a particular benefit. Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). In so doing, it is legally erroneous to ignore any claim limitation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

³ The Examiner required to make "clear and particular" factual findings as to any specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify the reference to arrive at the claimed invention. Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); Ecolochem Inc. v. Southern California Edison, Co., 222 F.2d 973, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Kotzaab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); In re Dembiczak, 175 F.2d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

the right to challenge the Examiner's assertion as to the officially noticed facts. Upon such a traverse by Applicant, the Examiner is to cite a reference to support the Examiner's position.

In this regard, Applicant respectfully submits that embedding a self-executing applet in a computer readable content to enforce usage permissions of content is not of such a notorious character to warrant "official notice" by the Examiner. Thus, Applicant traverses the Examiner's assertion, and if the Examiner continues to maintain this assertion, Applicant requests that the Examiner provide a factual basis of record for the assertion.

For the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 4-5, 25-28 and 31 under 35 U.S.C. § 103 for obviousness based upon Ginter is not viable and, hence, solicits withdrawal thereof.

CLAIMS 14-15 AND 22 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON STEFIK

On pages 11-12 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Stefik to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 14-15 and 22 dependent from independent claim 10, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 10 under 35 U.S.C. § 102 for anticipation based upon Stefik. Specifically, Stefik neither discloses nor suggests

embedding instruction code, corresponding to that claimed, in a computer readable medium.

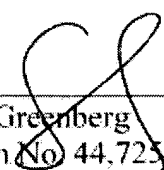
Applicant, therefore, respectfully submits that the imposed rejection of claims 14-15 and 22 under 35 U.S.C. § 103 for obviousness based upon Stefik is not viable and, hence, solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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